

C. J. Steel

6/16/03

REMARKS

Claims 40 and 47 are withdrawn. Claims 20 and 23 are currently amended. Claims 18-20, 23, and 41-46 are pending. In view of the following amendments and/or remarks, Applicant respectfully requests that the application be forwarded onto issuance.

The Claim Rejections

Claims 18-20, 23, and 40-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,606,712 to Hidaka (hereinafter, "Hidaka"). The Office admits differences between what Hidaka discloses and what the claims recite, stating that these differences are "Design Choice" matters to one having ordinary skill in the art.

Before undertaking a discussion of the substance of the Office's rejections, the following discussion of Hidaka is provided in an attempt to help the Office appreciate various distinctions between the claimed embodiments and Hidaka. Following this discussion, the standard for Design Choice rejections under 35 U.S.C. §103(a) will also be discussed.

The Hidaka Reference

Generally, Hidaka's disclosure is directed to memory areas that store various types of information having different formats. As part of this disclosure Hidaka mentions an electronic notebook. Hidaka then discloses a view showing "an external appearance of an information managing apparatus" in Fig. 1.

This apparatus is disclosed by Hidaka as showing an "LED cover 18 ... provided at one side edge portion of the cover 2". (Hidaka, column 5, lines 30-

31). Hidaka also states that the "LED cover 18 serves to extract light of a reception indicating LED (light Emitting Diode) from the front, side and back of the cover 2". (Hidaka, Col. 5, Lines 55-57).

Fig. 1 of Hidaka discloses the LED cover as being flush with the outer surfaces of the apparatus's cover. As apparent by viewing Fig. 1, Hidaka discloses the LED cover (marked 18) to be flush with top, end, and bottom surfaces of the cover 2 of the apparatus. (See Hidaka generally and at Fig. 1, reference 18).

"Design Choice" Rejections

First, rejection of claims as a "design choice" matter are appropriate when a change in an element's size or proportion "would not perform differently than the prior art device." (M.P.E.P. §2144.04(IV)(A), citing *Gardner v. TEC Systems, Inc.* 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984)).

Second, a "design choice" rejection of a claimed structure and the function it performs are proper only if they are not different from the prior art. *In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992) (finding of "obvious design choice" precluded where the claimed structure and the function it performs are different from the prior art).

Argument Generally

The test for patentability under 35 U.S.C. §103(a) is whether the subject matter would have been obvious to a person having ordinary skill in the art. The Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Piasecki*, 223 USPQ 785 (Fed. Cir. 1984). "If examination at the initial stage

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does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), citing *In re Grabiak*, 226 USPQ 870, 873 (Fed. Cir. 1985). A careful review of the record in this case will reveal that the Office has failed to establish a *prima facie* case, and that the Applicants are entitled to allowance of claims 18-20, 23, and 40-46.

The Claims

Applicant respectfully submits that the subject matter recited in each of the claims discussed below is patentably distinct from Hidaka, as will become apparent.

Claim 18, previously amended, recites a portable handheld computing device comprising:

- a casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces, the ends being dimensionally shorter than the front and back side surfaces; and
- a light emitting device mounted externally on the casing, the light emitting device being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces, the light emitting device being activated upon occurrence of an event to notify a user.

In making out various claim rejections in the present Office Action, the Office argues that the feature (18) of Figure 1 of Hidaka teaches an "LED being positioned on the upper surface and wrapping around and being raised on one of the end surfaces" (Paragraph 5 of Action dated March 27, 2003).

Applicant respectfully disagrees.

1 The figure cited by the Office shows an LED cover to be flush with top,
2 end, and bottom surfaces of the cover 2 of the apparatus. Such does not disclose
3 or suggest a light emitting device that is positioned on the upper surface and wraps
4 around to and is raised on one of the end surfaces.

5 The Office later admits this failing of Hidaka, stating that Hidaka "does not
6 expressly disclose the exact same physical shape of LED (i.e., physical situations
7 of the LED)". (Paragraph 5 of Action dated March 27, 2003). To address this
8 deficiency, the Office seems to reject Claim 18 on the basis that "such difference
9 in limitation is a design choice matter to one having ordinary skill in the art." (*Id.*)

10 As stated above, a "design choice" rejection of a claimed structure and the
11 function it performs is proper only if they are not different from the prior art. *In re*
12 *Gal*, 25 USPQ2d 1076. Claim 18 recites a structure of "the light emitting device
13 being positioned on the upper surface and wrapping around to and being raised on
14 one of the end surfaces". This structure is not taught or suggested by the flush
15 LED cover of Hidaka. Further, the function of the claimed structure includes the
16 light emitting device being viewable from angles and/or surfaces that the LED
17 cover of Hidaka does not disclose. (See Specification, Page 7, line 17 to Page 8,
18 line 1, and Figures 2a, 2b, and 2c). The claimed structure and the function it
19 performs are different from Hidaka. Accordingly, for at least this reason,
20 Applicant respectfully submits that this claim is allowable.

21 **Claims 23**, currently amended, now depends from claim 18 and is
22 allowable as depending from an allowable base claim. This claim is also
23 allowable for its own recited features that, in combination with those recited in
24 claim 18, are neither disclosed nor suggested in references of record, either singly
25 or in combination with one another.

1 The Office admits that Hidaka "does not expressly disclose ... off button
2 integration". (Paragraph 5 of Action dated March 27, 2003). To address this
3 deficiency, the Office states that "such difference in limitation is a design choice
4 matter to one having ordinary skill in the art", taking "official notice on such
5 design choice matter as off button integration." (*Id.*).

6 As in the prior Response, dated January 3, 2003, Applicant respectfully
7 objects to and traverses the taking of official notice. In accordance with
8 M.P.E.P. §2144.03, Applicant again requests that the Office produce art teaching a
9 "button being integrated with the light emitting device" in relation to a light
10 emitting device being activated upon occurrence of an event to notify a user. The
11 Office refers to Weber (U.S. Pat. No. 4,056,701) and Wunsch et al. (U.S. Pat. No.
12 4,454,596) but neither teaches a button integrated with a light emitting device in
13 relation to being activated upon occurrence of an event to notify a user. Lacking
14 such a reference or due to its dependency on base claim 18, Applicant respectfully
15 requests the §103 rejection of claim 23 be withdrawn.

16 **Dependent claim 41** is allowable at least by virtue of its dependency on
17 dependent claim 23 and base claim 18. This claim is also allowable for its own
18 recited features that, in combination with those recited in claims 18 and 23, are
19 neither disclosed nor suggested in references of record, either singly or in
20 combination with one another.

21 **Claim 19**, previously amended, recites a portable handheld computing
22 device comprising:

- 23
- 24 • a casing having a base and a lid; and
- 25

- a light emitting device mounted externally and raised on the lid, the light emitting device being activated upon occurrence of an event to notify a user.

Claim 19 recites a structure of "a light emitting device mounted externally and raised on the lid". This structure is not taught or suggested by the flush LED cover of Hidaka. Further, the function of the claimed structure includes the light emitting device being viewable from angles and/or surfaces that the LED cover of Hidaka does not disclose. (See Specification, Page 7, line 17 to Page 8, line 1, and Figures 2a and 2c). The claimed structure and the function it performs are different from Hidaka. Accordingly, for at least this reason, Applicant respectfully submits that this claim is allowable.

Claim 20, currently amended, recites a portable handheld computing device comprising:

- a casing having a base and a lid that opens and closes relative to the base, the lid having an upper surface, opposing side surfaces, and opposing end surfaces; and
- a light emitting device mounted externally on the casing, the light emitting device being activated upon occurrence of an event to notify a user, positioned on the upper surface of the lid, and wrapping around to one of the end surfaces so that the light emitting device is visible from both opposing side surfaces and both opposing end surfaces when the lid is opened or closed.

Claim 20 now recites a light emitting device "visible from both opposing side surfaces and both opposing end surfaces when the lid is opened or closed".

As stated above, to be a proper rejection as a design choice, a claimed feature must not perform differently than the prior art device. M.P.E.P. §2144.04(IV)(A).

1 The claimed light emitting device performs differently than that disclosed
2 by Hidaka. Hidaka does not teach or suggest a light emitting device that performs
3 the function of being "visible from both opposing side surfaces and both opposing
4 end surfaces when the lid is opened or closed". Thus, the claimed light emitting
5 device performs differently than the disclosure of Hidaka. Accordingly, for at
6 least this reason, Applicant respectfully submits that the claim is allowable.

7 Claim 42, previously added, recites a portable handheld computing device
8 comprising:

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- 10 • a casing having upper and lower surfaces, front and back side
surfaces, and opposing end surfaces; and
 - 11 • a light emitting device mounted externally on the casing,
 - 12 • wherein the light emitting device is:
 - 13 • activated upon occurrence of an event to notify a user; and
 - 14 • positioned such that the light emitting device is visible from the
upper surface, one of the side surfaces, and one of the end surfaces.

15 Claim 42 recites a light emitting device positioned such that "the light
16 emitting device is visible from the upper surface, one of the side surfaces, and one
17 of the end surfaces". As stated above, to be a proper rejection as a design choice,
18 a claimed feature must not perform differently than the prior art device. M.P.E.P.
19 §2144.04(IV)(A).

20 The claimed light emitting device performs differently than that disclosed
21 by Hidaka. Hidaka does not teach or suggest a light emitting device that performs
22 the function of being "visible from the upper surface, one of the side surfaces, and
23 one of the end surfaces". Thus, the claimed light emitting device performs
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1 differently than the disclosure of Hidaka. Accordingly, for at least this reason,
2 Applicant respectfully submits that the claim is allowable.

3 **Claims 43-46**, previously added, depend from claim 42 and are allowable
4 as depending from an allowable base claim. These claims are also allowable for
5 their own recited features that, in combination with those recited in claim 42, are
6 neither disclosed nor suggested in references of record, either singly or in
7 combination with one another.

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CONCLUSION

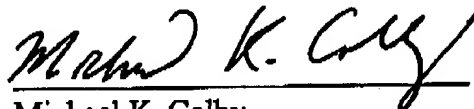
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All pending claims 18-20, 23, and 41-46 are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the subject application. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

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